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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL6115P0011US	2171

4743 7590 01/11/2005

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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/871,867

**Applicant(s)**

MALNEKOFF, PETER J.

**Examiner**

Yehdega Retta

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed October 12, 2004. Applicant amended claims 1, 8 and 15.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites computing a fair market price estimate based at least on the received cut proportions and claim 16 recites computing an adjustment factor based at least on the cut proportions and generating a pricing estimate from the base line price estimate and the computed adjustment factor. As recited in claim 15 the pricing estimate is computed based on cut proportion and as stated in claim 16 the adjustment factor is computed based on cut proportion. It is not clear whether there is a difference between the market pricing estimate, in claim 15, and the adjustment factor, in claim 16. Claim 16 also recites generating pricing estimate from the baseline price estimate and the adjustment factor. It is not clear if the baseline price estimate and fair market pricing estimate is the same. Applicant is required to amend the claim in order to clearly claim the invention.

Claim 16 recites the limitation "the baseline price". There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Aggarwal (6,236,867).

Regarding claim 1, an input device adapted to receive predetermined gemstone data supplied by a system user from a gemstone laboratory grading certificate including cut type, weight, color, etc., (see col. 1 lines 62 to col. 2 line 60 and col. 14 line 16 to col. 16 line 27) processing device adapted to compute a pricing estimate for use in an evaluation report based at least upon the cut proportion and an output adapted to communicate the evaluation report to the system user (see col. 5 lines 1-37 and col. 16 lines 28-39) (see also the provisional application pp 3 line 26 to page 4 line 7, pp 6 lines 25-30, pp 13 lines 24 to pp 14 line 3 and fig. 21).

Regarding claim 2, Aggarwal teaches report including qualities of the gemstone (see col. 15 line 1-18 and col. 16 lines 28-38).

Regarding claim 4, Aggarwal teaches allowing the gemstone data to be received from a remotely located device and allowing the report to be communicated to the remotely located device (see col. 5 line 38 to col. 7 line 47).

Regarding claims 5 and 6, Aggarwal teaches printer for printing the evaluation report and display screen (see fig. 1 and col. 6 lines 27-57).

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Regarding claim 7, Aggarwal teaches system user, inputting data. Whether the user is a consumer or not does not change the claimed feature of entering data in the system of Aggarwal. Therefore, no patentable weight is given to the user being a consumer.

Claims 8, 15 and 16 are rejected as stated above in claim 1.

Claim 9 is rejected as stated above in claim 2.

Claim 11 is rejected as stated above in claim 4.

Claims 12, 13 and 18 are rejected as stated above in claims 5 and 6.

Claim 14 is rejected as stated above in claim 7.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal (6,236,867) in view of Vanier et al. U.S. Patent No. 5,828,405.

Regarding claims 3 and 10, Aggarwal does not teach price estimate including a separate price estimate for each of different types of retail outlets. Vanier teaches appraised value of jeweler being entered and stored in a database (see col. 6 lines 40-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide different price for different retail store, since different type of stores pay different price for gemstones and sell it for different price.

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Regarding claim 17, Aggarwal teaches indexing data structure, based on cut style weight, color and clarity of the gemstone, reading indexed list price value (see col. 14 line 66 to col. 16 line 39). Aggarwal does not teach adjusting price value based on jeweler pricing adjustment. Vanier teaches jewelers entering appraised value of gemstone appraised valued being stored in a database, the value being high from which there is a substantial discount. It would have been obvious to one of ordinary skill in the art at the time of the invention to appraise the gemstone according to jeweler price, from which the gemstone was purchased or sold, since different retail stores pay different price for the gemstones.

#### ***Response to Arguments***

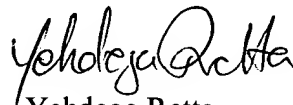
Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yehdega Retta  
Primary Examiner  
Art Unit 3622

YR